

REMARKS/ARGUMENTS

Reconsideration is respectfully requested of the Office Action of July 20, 2005, relating to the above-identified application.

The claims have been amended to more particularly point out and distinctly claim applicants' contribution to the art and to place the claims in more grammatically correct format.

Claim 9 has been deleted; the issue raised in the Official Action on page 2, with respect to the drawings, is now considered moot.

It should be noted that Claims 1, 3-8 and 10-20 are directed to the license plate holding bracket. Hence, the other parts of the vehicle, such as the tailgate and the rear bumper are not intended as positive limitations but merely to explain the environment in which the claimed license plate holding bracket functions.

In view of the foregoing amendments, it is believed that the objection to Claims 1-21, based on formalities recited beginning on page 3 of the Official Action have been overcome and reconsideration is requested.

The rejection of Claims 12 and 20, under 35 U.S.C. § 112 (first paragraph), is traversed and reconsideration is respectfully requested. The claims have been amended to delete the word "welded" and, therefore, it is believed the claims now overcome the rejection.

The rejection of Claims 12-20, under 35 U.S.C. § 112 (second paragraph), is traversed and reconsideration is respectfully requested. The claims have been amended to redefine the "welded bolt" as a "bolt" and have also been amended to clarify the member with the groove. It is believed that the foregoing amendments also address the objections recited by the Examiner concerning Claim 14 which are found on page 6 of the Official Action.

In view of the foregoing amendment, it is believed that all these objections and rejections have been overcome.

The rejection of Claim 1 under 35 U.S.C. § 102(e) as anticipated by the published patent application 2003/0127879 to *Smith* is traversed and reconsideration is respectfully requested. Claim 1 has now been amended to specify the stopper provided on the rear plate holding member for contacting the rear bumper when the tailgate is approximately horizontal. *Smith* does not show such a configuration and, therefore, fails to anticipate the claimed invention.

Withdrawal of the rejection is therefore respectfully requested.

The rejection of Claim 2-4, 6 and 21, under 35 U.S.C. § 103(a) as unpatentable over the published patent application of *Smith*, taken with the Japanese publication 2004-182152 of *Ofu* is traversed and reconsideration is respectfully requested.

Smith does not disclose a stopper since the member which is identified in the Official Action in Figure 6 of the reference is not identified as a “stopper” by the *Smith* reference. Nor does the device shown in Figure 6 of the *Smith* application contact the rear bumper. The Official Action relies on the reference of *Ofu* to meet this deficiency. However, the specification of *Ofu* contains no explanation of the member on the plate holding member in Figure 4. In view of the lack of description, *Ofu* fails to disclose a stopper to avoid unnecessary vibration of the license plate.

Ofu completely fails to disclose a stopper for contacting the rear bumper when the tailgate is approximately horizontal and the license plate is approximately vertical. Therefore, persons skilled in the art wishing to avoid unnecessary vibration of the license plate would not be motivated to combine the device of *Ofu* with the license plate holding bracket of *Smith*.

Accordingly, applicants respectfully submit that there is no reason or suggestion in *Ofu* whereby a person skilled in the art would be lead to believe that there is some advantage or benefit to be obtained by changing the configuration shown by *Smith*.

The rejection of Claim 5 under 35 U.S.C. § 103(a) as unpatentable over the published application of *Smith*, taken with the Japanese document of *Ofu* and further in view of the US patent of *Bott* (US 4,302,896), is traversed and reconsideration is respectfully requested.

Smith and *Ofu* have already been discussed above and the comments apply here as well. The patent of *Bott* simply discloses elastic bumpers and contains no teaching or suggestion which would lead a person skilled in the art to believe that there would be some benefit to incorporate elastic bumpers into the configuration of *Smith* and *Ofu*. It has already been pointed out that *Smith* does not disclose a bumper meeting the terms as defined in Claim 5 which depends on Claim 1 and, therefore, applicants submit that the combination of references fails to establish *prima facie* obviousness of the claimed invention.

The rejection of Claim 7 under 35 U.S.C. § 103(a) as unpatentable over the published application of *Smith*, taken with the Japanese publication of *Ofu* and further in view of the US patent of *Irie* (US 1,573,113) is traversed and reconsideration is respectfully requested. The Official Action admits that the *Smith* and *Ofu* documents do not disclose a lock mechanism with a latch arranged on the side of the plate holding member and a striker arranged in the side of the gate side fixing member and a bias member. However, *Irie* fails to teach that there is any benefit or advantage to changing the configuration of *Smith* to provide the features shown by *Irie*. Consequently, applicants respectfully submit there is no motivation for a person skilled in the art to modify the structure of *Smith* by incorporating details from *Irie*.

The rejection of Claims 8-12 under 35 U.S.C. §103(a) as unpatentable over the published application of *Smith*, taken with the Japanese publication of *Ofu* and further in view of the US patent 4,270,287 of *Gimbel*, is traversed and reconsideration is respectfully requested.

The Official Action admits that *Smith* and *Ofu* do not disclose a plate holding member having a hole therein and a resin member with a hook for detachably engaging the periphery of the hole and a fixing member which is for fixing the resin member which could contact the tailgate when the license plate is parallel with the tailgate and a bolt arranged in the plate holding member and a nut.

Considering that Claims 8-12 are dependent on Claim 1, applicants respectfully submit the combination of references fails to establish any reason or suggestion whereby a person skilled in the art would change or modify the structure of *Smith* to arrive at the claimed invention. Absent a teaching of a benefit or advantage, there is no motivation for a person skilled in the art to arbitrarily combine various elements from the prior art to assemble, after the fact, the claimed structure of this invention. Accordingly, applicants respectfully submit that the combination of references fails to create *prima facie* obviousness of the claimed invention.

The rejection of Claims 13-15 as allegedly unpatentable under 35 U.S.C. § 103(a) in view of the *Smith* published application and further in view of the US patent of *Irie* is traversed and reconsideration is respectfully requested.

The Official Action relies on *Irie* to show a holding bracket with a gate side fixing member and a rotatable plate holding member having a lock mechanism that includes a latch on a side of the plate holding member and striker arranged in the side of the gate side fixing member and a biasing member. The Official Action concludes that it would have been obvious to add a

lock mechanism in order to detachably lock the elements one to another and to bias the two elements in the desired direction. However, it has already been pointed out that *Smith* fails to show the basic structure of the invention and the feature of the stopper provided on the plate holding member for contacting the rear bumper. Absent this feature, even if the references are combined, a person skilled in the art would still not arrive at applicants' invention. Accordingly, it is respectfully submitted that the combination of references fails to establish *prima facie* obviousness of the claimed invention.

The rejection of Claims 16-20 under 35 U.S.C. § 103(a) as being unpatentable over the published application of *Smith*, taken with the US patent of *Irie*, and further in view of the US patent of *Gimbel* is traversed and reconsideration is respectfully requested. Although the Official Action alleges that *Smith* and *Irie* show the basic inventive concept, the Official Action fails to point out the specific elements found in the rejected claims which are shown in the reference. In fact, the references, either individually or any combination thereof, fail to show the elements recited in Claim 1, upon which Claims 16-20 depend. Applicants note that it is not enough for the references to show "the basic inventive concept" of the invention. Instead, the references must teach the elements in the combination set forth, and the motivation to combine them, in order to be a proper rejection under 35 U.S.C. § 103(a).

To establish a *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

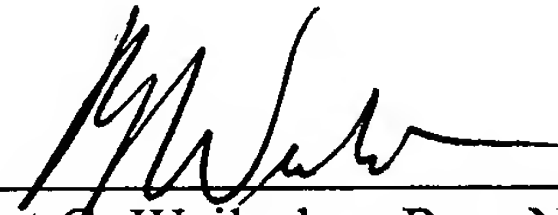
The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

A statement that the modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 2d, 1300 (Bd. Pat. App. & Int. 1993).

For the foregoing reasons, applicants request reconsideration and favorable action at the Examiner's earliest convenience.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: 
Robert G. Weilacher, Reg. No. 20,531

Suite 3100, Promenade II
1230 Peachtree Street, N.E.
Atlanta, Georgia 30309-3592
Telephone: (404): 815-3593
Facsimile: (404): 685-6893